

REMARKS

The Official Action mailed March 31, 2004, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to July 31, 2004. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on January 28, 2002, April 3, 2000, June 10, 2002, November 22, 2002, and January 23, 2003. Regarding the IDS filed January 28, 2002, the Applicants submit the attached *Request for Corrected PTO 1449 Form* which corrects a typographical error and consideration of this *Request for Corrected PTO 1449 Form* is respectfully requested.

Claims 1-83 were pending in the present application prior to the above amendment. Claims 22 and 36 have been canceled, claims 9 and 23 have been amended to better recite the features of the present invention, and claim 81 has been amended to correct a minor typographical error. Accordingly, claims 1-21, 23-35 and 37-83 are now pending in the present application, of which claims 1, 3, 5-7, 9, 23, 37, 51, 63, 75, 78 and 81 are independent. Claims 1-8, 37-74 and 78-80 have been withdrawn from consideration. Accordingly, claims 9-36, 75-77 and 81-83 are currently elected, of which claims 9, 23, 75 and 81 are independent. The Applicants note with appreciation the allowance of claims 81-83 (page 4, Paper No. 03262004). For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 9-36 under the doctrine of obviousness-type double patenting over claims 49-114 of co-pending U.S. Patent Application No. 10/051,064 to Hamada. The Applicants respectfully submit that the subject application is patentably distinct from the claims of the Hamada application.

As stated in MPEP § 804, under the heading "Obviousness-Type," in order to form an obviousness-type double patenting rejection, a claim in the present application

must define an invention that is merely an obvious variation of an invention claimed in the prior art patent, and the claimed subject matter must not be patentably distinct from the subject matter claimed in a commonly owned patent. Also, the patent principally underlying the double patenting rejection is not considered prior art.

The Applicants respectfully traverse the obviousness-type double patenting rejection because independent claims 9 and 23 of the present invention are patentably distinct from the claims of the Hamada application. Specifically, independent claims 9 and 23 as amended herewith recite forming a second semiconductor film containing a rare gas element on the barrier layer by plasma CVD method or high-frequency sputtering method. The claims of the Hamada application do not teach or suggest at least the above-referenced features of the present invention.

Therefore, the Applicants respectfully submit that the subject application is patentably distinct from the claims of the Hamada application. Reconsideration of the obviousness-type double patenting rejection is requested.

Paragraph 5 of the Official Action rejects claims 75 and 76 as anticipated by U.S. Patent No. 5,789,284 to Yamazaki et al. The Applicants respectfully traverse the rejection because the Official Action has not provided a sufficient showing that Yamazaki discloses or suggest each and every limitation of the claims to maintain an anticipation rejection. As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present invention. The Applicants respectfully submit that Yamazaki, either explicitly or inherently, does not disclose the following processes of independent claim 75 of the present invention nor the order of the processes: irradiating a crystallized semiconductor film with a light so that the crystallized semiconductor film is melted at least partly; and removing a metal from the

crystallized semiconductor film by gettering after the irradiation of the light. It appears that Yamazaki and the Official Action are silent as to these features. Therefore, Yamazaki does not teach all the elements of the independent claims, either explicitly or inherently.

Since Yamazaki does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 7 of the Official Action rejects claim 77 as obvious based on Yamazaki. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art does not teach or suggest all the features of the independent claims. As noted above, Yamazaki does not teach or suggest irradiating a crystallized semiconductor film with a light so that the crystallized semiconductor film is melted at least partly; and removing a metal from the crystallized semiconductor film by gettering after the irradiation of the light. It appears that Yamazaki and the Official Action are silent as to these features.

Since Yamazaki does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789